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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,413	10/26/2006	Toshihiko Ohtomo	14875-164US1 C1-A0321P-US	7418
26161	7590	10/20/2008	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			DUFFY, BRADLEY	
			ART UNIT	PAPER NUMBER
			1643	
			NOTIFICATION DATE	DELIVERY MODE
			10/20/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10582413 A0321P-US	10/26/2006	OHTOMO ET AL.	14875-164US1 C1-

EXAMINER

BRADLEY DUFFY

ART UNIT**PAPER**

1643

20081014

DATE MAILED:

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Commissioner for Patents***Detailed Action***

1. The examiner of the instant application has changed at the Patent and Trademark office. Please direct future inquiries concerning this application to Brad Duffy whose telephone number is (571) 272-9935.

Notice of Non-Responsive Amendment

2. The amendment filed June 30, 2008, is non-responsive for the following reason:

The amendment filed June 30, 2008, would cancel all claims, which were previously drawn to the elected invention, so as to present only new claims drawn to a non-elected invention.

The newly presented claims are not readable on the elected invention for the following reasons:

In this case, new claims 20-39 are directed to multiple processes without a stated intended use that produce "a covalently linked scFv multimer" (see claim 20), "a single-chain polypeptide" (see claim 21 and 39) or "an sc(Fv)²" (see claim 35). In contrast, the originally presented claims, which were drawn to the elected invention, were directed to methods of enhancing the activity of an antibody. Thus, while newly presented claims 20-39, might encompass the elected invention, the claims are directed to far broader subject matter, which might include, for example, any other process, apart from the elected invention, that produces "a covalently linked scFv multimer" (see claim 20), "a single-chain polypeptide" (see claim 21 and 39) or "an sc(Fv)²" for any use. Furthermore, as set forth in the restriction requirement mailed January 4, 2008, the technical feature recited in claim 1 is enhancing the activity of an antibody by making the antibody into a single-chain polypeptide comprising two or more light chain variable regions and two or more heavy chain variable regions which lacks inventive step in view of Fukushima, et al. (US PG PUB 2004/0058393, PCT filed April 17, 2001). Accordingly, it is submitted that the methods instantly do not share the same technical feature as the elected invention.

Therefore, it is apparent that the newly presented claims encompass methods which differ so substantially from the breath of the originally presented claims drawn to methods of enhancing the activity of an antibody that an examination of the new claims would require different considerations and/or searches, which were not before necessary for the elected invention. Moreover, the far broader scope of the claims, as would be amended, would require a different field of search (e.g., searching additional and/or different classes/subclasses or electronic resources, and/or employing additional and/or different search queries). Notably, were the claims to

be examined, the far broader scope of the claims, as would be amended, would be likely to raise different non-prior art issues under 35 U.S.C. §§ 101 and/or 35 U.S.C. 112, first paragraph, which pertain to the corresponding utility requirement and/or enablement and/or written description requirements. For example, since the claims do not assert any utility for the claimed methods, it appears that the newly presented claims would require a rejection under 35 U.S.C. § 101. Moreover, the far broader scope of the claims, as would be amended, would appear to require a 35 U.S.C. 112, first paragraph, for containing NEW MATTER.

As such, examination of the instantly presented methods in these newly added claims would be unduly burdensome.

Accordingly, after entry of the amendment, all remaining claims would be withdrawn from consideration as being directed to non-elected inventions, and therefore the amendment, which presents only claims drawn to such non-elected inventions, is non-responsive and has not been entered. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant is further reminded, because claims 20-39 have not been entered, subsequent claim amendments should use the status identifier (not entered) for claims 20-39 with no claim text being presented for these claims. See MPEP 714 which states: "The status identifier (not entered) is used for claims that were previously proposed in an amendment (e.g., after-final) that was denied entry." and "Canceled and not entered claims must be listed by only the claim number and status identifier, without presenting the text of the claims."

Accordingly, if Applicant wishes to present any new claims for consideration, then such claims should be numbered starting consecutively after the claim with the highest number previously presented, in this case claim 40 with the status of "new" and without claim markings. See also 37 CFR § 1.126 which states: "When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not)". See also 37 CFR § 1.121 for the requirements of making amendments.

3. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brad Duffy whose telephone number is (571) 272-9935. The examiner can normally be reached on Monday through Friday 7:00 AM to 4:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully,
Brad Duffy
571-272-9935

/bd/
October 1, 2008

/Stephen L. Rawlings/
Primary Examiner, Art Unit 1643